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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,287	10/23/2001	Michelle F. Browner	018781-005710US	3796

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EXAMINER
BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/30/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/004,287

Applicant(s)

BROWNER ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-10,12-30,32-43,48-52,54-64,69-73 and 75-91 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-10,12-30,32-43,48-52 and 54-63 is/are allowed.
- 6) ☐ Claim(s) 64, 69-73 and 75-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response, which included cancellation of claims 2-5, 11, 31, 44-47, 53, 65-68, 74 and 92-101, and amendment to claims 1, 6-9, 12-13, 22, 42-43, 54-55, 64, 69-72, 75-76, and 90-91, filed on 7/31/2003, is made of record.

Claims 1, 6-10, 12-30, 32-43, 48-52, 54-64, 69-73, and 75-91 are now pending.

In view of applicants' response, particularly amendment to claims 1, 6-10, 12-30, 32-43, 48-52, 54-64, 69-73, and 75-91, 103(a) rejection over Wang et al. WO 98/47869 made in the previous office action has been deemed as obviated.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64, 69-73 and 75-91 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for rheumatoid arthritis, does not reasonably provide enablement for any or all TNF- $\alpha$  mediated disorders including those yet to be discovered as due to TNF- $\alpha$ . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Following reasons apply.

The instant claims 64, 69-73, and 75-91 are drawn to "treating an inflammatory, or cancer ". The scope of the claims includes not only any or all conditions but also those condition yet to be discovered as due to IKK mediated TNF- $\alpha$  for which there is no enabling disclosure. In addition, the scope of these claims includes treatment of

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various diseases, which is not adequately enabled solely based on the inhibiting expression of TNF- $\alpha$  activity mediated by IKKK of the compounds provided in the specification pages 24 and 100-101. The instant compounds are disclosed to have inhibiting IKK mediated expression of TNF- $\alpha$  activity and it is recited that the instant compounds are therefore useful in treating any or all diseases where TNF- $\alpha$  activity is implicated, for which applicants provide no competent evidence. Furthermore, the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases such as Alzheimer's disease, multiple sclerosis, psoriasis etc. are very difficult to treat and at present there is no known drug, which can successfully reverse the course of these diseases, despite the fact that there are many drugs, which can be used for "inflammatory condition". In addition, the amended claims includes treating cancer, which includes all or any cancer. Note the claim language does not even recited those mediated by TNF- $\alpha$ . No compound has ever been found to treat cancers of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "compound" is contrary to our present understanding of oncology. Cecil Textbook of Medicine states, "each specific type has unique biologic and clinical features that must be appreciated for proper diagnosis, treatment and study" (see the enclosed article, page 1004). Different types of cancers affect different organs and have different methods of growth and harm to the body. Thus, it is beyond the skill of oncologists today to get an agent to be effective against

cancers generally. Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses. Next, applicant's attention is drawn to the Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. The state of the art is indicative of the requirement for undue experimentation. See Graninger et al. *Curr. Opin. Rheumatol.* 13(3) 209-13, 2001 (PubMed Abstract provided) and Shaw et al. *Expert Opin. Investig. Drugs* 9(7) 1469-1478, 2000 (PubMed Abstract provided). In addition, applicants clearly admit that the IKK mediated inhibiting expression of TNF- $\alpha$  activity is still unclear. See page 2, lines 30-33.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

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- 1) The nature of the invention: Therapeutic use of the compounds in treating diseases that require IKK mediated inhibiting expression of TNF- $\alpha$  activity.
- 2) The state of the prior art: A very recent publication expressed that treating disease by the inhibition of IKK mediated expression of TNF- $\alpha$  is still exploratory.
- 3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating any or all condition of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).
- 4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating any or all condition and the state of the art is that the effects of IKK mediated inhibiting expression of TNF- $\alpha$  activity are unpredictable and at best limited to modulation of rheumatoid arthritis.
- 6) The breadth of the claims: The instant claims embrace any or all condition including those yet to be related to expression of TNF- $\alpha$  activity.
- 7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of receptor-ligand interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

This rejection is same as made in the previous office action but excludes cancelled claims.

Applicants' argument to overcome this rejection is not persuasive.

1. First of all the issue is whether the instant claims meet the 112 first paragraph requirement of the patent law. More specifically, as per Revised Interim Utility and Written Description Guidelines, at 64 FR 71427 and 71440 (December 21, 1999) 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method of treating any or all inflammation or cancer solely based on the inhibitory activity disclosed for the compounds. Again note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support in vivo uses.

2. Again, as noted above, the claim language does not even state those mediated by TNF- $\alpha$  and therefore read on any or all mode of action for which there is no enabling disclosure.

3. None of the references cited by the applicants provide support for any or all diseases. In fact, careful analysis of the references, lend support for treating rheumatoid arthritis but not all or any diseases or treating any or all cancer.

Hence this rejection is proper and is maintained.

***Allowable Subject Matter***

Claims 1, 6-10, 12-30, 32-43, 48-52, and 54-63 are allowed. Said claims would be allowed since specific species embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*V. Balasubramanian*  
Venkataraman Balasubramanian

09/29/2003